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10/697,436	10/31/2003	Shinichi Ito	04329.2437-02	7730

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EXAMINER

BAREFORD, KATHERINE A

ART UNIT PAPER NUMBER

1762

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/697,436

Applicant(s)

ITO, SHINICHI

Examiner

Katherine A. Bareford

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) 11-13 and 18-24 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 15-17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

*claims 1-10 and 14 are canceled*

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 09/669,725.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/03.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group III, claims 15-17, in the reply filed on Jan. 21, 2005 is acknowledged.
2. Claims 11-13 and 18-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on Jan. 21, 2005.

### *Drawings*

3. The replacement drawings were received with the preliminary amendment filed with the application on October 31, 2003. These drawings are approved.

### *Specification*

4. The disclosure is objected to because of the following informalities: in the first paragraph of the application, which was amended on October 31, 2003, applicant should clarify that application 10/144,028 is now U.S. Patent No. 6, 669,982.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 15-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In independent claim 15, lines 9-12, it is provided that the relative movement can be such that it "is composed of spiral movement in which the dropping unit goes from the substantial center of the substrate to the periphery thereof or from the periphery of the substrate to the substantial center thereof". However, if such relative movement is provided, it is impossible to see how the claimed invention's process steps can be performed. For example, if the initial dropping point is in at the periphery and the ending point is at the center, how can the distance from the starting point to the edge of the substrate be larger than the distance from the ending point to the edge of the substrate? Moreover, how would the distance between an end of the film along the file direction and the edge gradually become smaller from the dropping start position to the dropping finish position? Thus, it appears that if such movement is provided, the invention would be not be enabled as it could not be performed.

The other dependent claims 16-17 do not cure the defects of the claims from which they depend.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15, lines 1-2, it appears that "adjusted to be spread into a give amount on a substrate to be processed" would be better worded as "to be spread on a substrate" as it is unclear what is required by "adjusted" or "give (given?) amount".

Claim 15, line 8, "space of" should apparently be "space over", as the passes through space "over" the substrate.

Claim 15, line 9, "outside" is unclear as to what is required, as the embodiment in the specification with regard to figures 16 and 23 does <sup>not</sup> ~~to~~ show that the movement is outside of the substrate. Does applicant mean "across" the substrate?

Claim 15, line 13, "relationship" should apparently be "a relationship" for correct grammatical usage.

Claim 15, line 14, "a boundary step of the edge of the substrate" is unclear as to what is required. How is the "boundary step" related to "the edge of the substrate"? Furthermore, as to the distance between a dropping start position and "a boundary step at the edge of the substrate", it is unclear how this distance is measured, because it is unclear (1) what the boundary step is and (2) which edge area of the substrate is referred to. The substrate would have various edge areas, as shown by figure 23, which shows left and right edges and also north and south edges.

Claim 15, line 14, “and that from” should be “and the distance from” to clarify that a distance is referred to.

Claim 15, line 15, “the boundary step of the edge thereof” is unclear as to what is required. How is the “boundary step” related to “the edge of the substrate”? Furthermore, as to the distance between a dropping end position and “the boundary step at the edge thereof”, it is unclear how this distance is measured, because it is unclear (1) what the boundary step is and (2) which edge area of the substrate is referred to. The substrate would have various edge areas, as shown by figure 23, which shows left and right edges and also north and south edges. In this case, since “the boundary step” is referred to it appears to be referring to the boundary edge referred to with regard to the starting position. However, from the specification and figures 16 and 23 it appears that the measurement is intended to be taken from a different edge.

Claim 15, line 16, as to “large” and “small” it is unclear as to what is required as to the limitations of the size between the former and latter distances. When does a size become “large” and when is it “small”. Does applicant mean that former distance is “relatively” large and the latter distance is “relatively” small compared with each other?

Claim 15, lines 16-17, “the distance between and end of the liquid film along the file direction and the boundary step of the edge” is unclear as to what is required. How is the “boundary step” related to “the edge”? Furthermore, as to the distance between a the end of the film and “the boundary step of the”, it is unclear how this distance is measured, because it is unclear (1) what the boundary step is and (2) which edge area of the substrate is referred to. The substrate would have various edge areas, as shown by figure 23, which shows left and right edges

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and also north and south edges. In this case, since "the boundary step" is referred to it appears to be referring to the boundary edge referred to with regard to the starting position. However, from the specification and figures 16 and 23 it appears that the measurement is intended to be taken from a different edge.

103 Claim 15, lines 13-18, this describes distance relationships, which as described in the specification <sup>and at Figures</sup> ~~at pages 16 and 23~~, appear to require that all of the application of coating occurs on the substrate, with an edge area of the substrate that is not coated. However, from the wording of the claim, it appears that the dropping point, etc. could occur outside of the substrate, so that during the coating the entire substrate is covered. It is unclear how the invention would work if this is the case.

The other dependent claims do not cure the defects of the claims from which they depend.

### *Double Patenting*

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

10. Claims 15-17 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 15-17 of copending Application No. 10/697,260. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 15-17 of the present application and claims 15-17 of 10/697,260 (see U.S. 2004/0091606 A1) are identical.

### *Conclusion*

11. Yoshiba et al (US 5776545) teaches a method of coating a substrate where relative movement between the dropping unit and the substrate is composed of straight movement along a file direction in which the dropping unit passes from one end side of the substrate through an upper space over the substrate to the other end side of the substrate and a movement along the rank direction across the substrate. See figures 2 and 8 and column 3, lines 1-15. However, Yoshiba does not teach controlling the starting points and ending points as is now claimed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (571) 272-1413. The examiner can normally be reached on M-F(6:30-4:00) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1415. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications.

Other inquiries can be directed to the Tech Center 1700 telephone number at (571) 272-1700.

Furthermore, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for




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unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**KATHERINE BAREFORD**  
**PRIMARY EXAMINER**